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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/955,923	09/19/2001	Christian Huitema	30835/183230	9393
45373 7590 12/19/2006 MARSHALL, GERSTEIN & BORUN LLP (MICROSOFT) 233 SOUTH WACKER DRIVE 6300 SEARS TOWER CHICAGO, IL 60606			EXAMINER BLAIR, DOUGLAS B	
			ART UNIT 2142	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		12/19/2006	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 09/955,923	Applicant(s) HUITEMA ET AL.	
	Examiner Douglas B. Blair	Art Unit 2142	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>6/26/2006</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. In view of the Appeal Brief filed on 9/26/2006, PROSECUTION IS HEREBY REOPENED. A new grounds of rejection is set forth below.
2. To avoid abandonment of the application, appellant must exercise one of the following two options:
 - (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
 - (2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.
3. A Supervisory Patent Examiner (SPE) has approved of reopening prosecution.
4. Applicant's arguments, see Appeal Brief, filed 9/26/2006, with respect to the rejection(s) of claim(s) 1-11 under 35 USC section 102 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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6. Claim 11 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Though claim 11 states that the computer readable medium is tangible it does not satisfy the requirements of 35 USC section 101 because the explicit statement of tangibility is conclusory without providing the evidence of tangibility.

7. The following amendment is suggested for claim 11:

11. A ~~tangible~~ computer-readable storage medium ~~having~~ storing computer-executable instructions for performing the method of claim 1.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-2, 6-9 and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Number 5,369,705 to Bird et al..

10. As to claim 1, Bird teaches a method of forming a peer-to-peer group, comprising the steps of selecting a friendly name for the group (col. 11, lines 29-31, the group identifier list is considered the friendly name), calculating a category identification (CID) for the group (col. 11 lines 39-49, the group name is calculated by hashing the group identifier list), and providing the CID to a peer (col. 12, lines 27-29, all group members can calculate the group name from the

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identifier and col. 12 lines 31-35 show sending the identifier, thus Bird teaches providing the CID to a peer).

11. As to claim 2, Bird teaches the method of claim 1, wherein the step of calculating the CID comprises the step of hashing the friendly name with a seed group (col. 11, lines 39-49, the 64 bit value is the seed group).

12. As to claim 6, Bird teaches the method of claim 1, further comprising the steps of receiving a connect message from the peer and returning a welcome message to the peer (col. 11, line 53-col. 12, line 16).

13. As to claim 7, Bird teaches the method of claim 6, further comprising the steps of calculating a signature of a group object database, and sending the signature to the peer (col. 12, line 24-col. 13, line 59).

14. As to claim 8, Bird teaches the method of claim 7, wherein the step of calculating a signature of a group object database comprises the steps of combining a unique identification, sequence number, and age for each group object in the group object database, and storing a list of the combined UIDs/SNUMS/ages for the group objects (col. 12, line 24-col. 13, line 59).

15. As to claim 9, Bird teaches the method of claim 7, further comprising the steps of receiving a request for specific group objects from the peer, and transmitting the specific group objects to the peer (col. 12, line 24-col. 13, line 59).

16. As to claim 11, Bird teaches the method of claim 1 being executed on a computer readable medium.

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17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claims 1-6 and 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication Number 2005/0004984 by Simpson in view of U.S. Patent Number 6,141,760 to Abadi et al.

19. As to claim 1, Simpson teaches a method of forming a peer-to-peer group, comprising the steps of selecting a friendly name for the group and providing the group to a peer (paragraphs 73-76); however Simpson does not explicitly teach providing the hashed name to a peer.

Abadi teaches the provision of a hashed friendly name to a peer (col. 3, lines 34-45).

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of Simpson regarding a peer-to-peer chat system with the teachings of Abadi regarding hashing friendly name because the hash function allows multiple entities to share the same friendly name (Abadi, col. 1, lines 18-30).

20. Claims 1-11 are rejected under 35 U.S.C. 102(e) as being anticipated by .

21. As to claim 2, Abadi teaches a step of calculating an ID by hashing (col. 3, lines 34-45).

22. As to claim 3, Abadi teaches the method of claim 1 wherein the peer-to-peer group is to be private, wherein the step of providing the ID to a peer comprises the step of sending the ID to the peer out of band (col. 3, lines 52-62).

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23. As to claim 4, Simpson teaches the method of claim 1 wherein the peer to peer group is to be public wherein the step of providing the ID to a peer comprises the step of registering the ID with a peer-to-peer name resolution protocol (PNRP) for discovery (paragraphs 73-76).

24. As to claim 5, Simpson teaches the method of claim 4, further comprising the steps of concatenating a peer ID with the ID (paragraphs 73-76).

25. As to claim 6, Simpson teaches the method of claim 1 further comprising the steps of receiving connect messages from the peer and returning a welcome message to the peer (paragraphs 73-76).

26. As to claim 10, Simpson teaches the method of claim 1 further comprising the steps of receiving a connect message form a peer an returning a refuse message to the peer along with a list of other members of the group (paragraphs 73-76).

27. As to claim 11, Simpson teaches a computer readable medium.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Douglas B. Blair whose telephone number is 571-272-3893. The examiner can normally be reached on 8:30am-5pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on 571-272-3868. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Douglas Blair

DBB



ANDREW CALDWELL

NY PATENT ATTORNEY